

REMARKS

This paper is submitted in response to the Office action mailed March 7, 2006.

The Examiner is thanked for noting that the Priority claim to Serial No. 60/318,221 was not yet inserted into the specification explicitly. This claim was first raised in the inventor declaration that was submitted March 29, 2002 (in response to the notice of incomplete application). Because this Priority claim became of record within four months from the actual filing date or sixteen months from the filing date of the prior application, the undersigned has amended the written description to include an express reference to the cited application. No petition to accept an unintentionally delayed benefit claim is believed to be necessary here, as the priority claim is believed to have been made of record in a timely manner. The filing receipt mailed May 1, 2002 is consistent with the specification as proposed to be amended. Thus, entry of this proposed amendment to the specification is requested.

Claims 1-63 were rejected under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter of the invention. The Examiner's comments in this regard appear to be well taken. According, the following phrases have been omitted or rewritten for clarity: "preferentially in real-time" (claims 1, 58 and 61); "the optimal value" (claim 16); "assuming that each message alternative is content" (claim 28); "said allocation algorithm" (claims 31, 41-44); and "warrant" (claims 48-49). In reviewing the claim set, it was believed that certain other wording changes would be helpful in making the claims more readable. These changes have been included herein.

The claims are now deemed to fully satisfy 35 USC 112, second paragraph. Of course, the undersigned stands ready to work with the Examiner to address any remaining language deficiencies.

The "system" claims 61-63 have been cancelled, as these claims were considered redundant of the "method" and "computer program" product claims. New claims 64-66 have been added to provide the Applicants with protection for additional aspects of the invention, namely, the specific details of the multiattribute system. The prior art does not remotely disclose or suggest this specific subject matter.

Turning to the art rejections, claims 1, 7, 9-10, 13-14, 16-18, 45-46, 48-50, 58 and 61-63 were rejected under 35 USC 102(e) as anticipated by Merriman et al., U.S. Published Patent Application No. 2002/0099600. This rejection, however, is traversed. The Manual of Patent Examining Procedure (MPEP) § 2131 provides that a “claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. ... ‘The identical invention must be shown in as complete detail as contained in the ... claim.’ The elements must be arranged as required by the claim.” (citations omitted, emphasis supplied). This rigid legal standard was not met by Merriman et al. In this regard, please consider original claim 1, which concerned “multiattribute analysis and optimization” wherein “attributes and attribute values of message alternatives” are used to improve the “stage-to-stage performance of said message alternatives.” The original claims also required “a multiattribute system that described the message alternatives in terms of the attributes and the attribute values.” As described throughout the written description, the “attributes” and “attribute values” are characteristics of the message alternatives (or so-called “creatives”) themselves. (See, e.g., the discussion beginning on page 17 and continuing through page 23). A “multiattribute system” is a collection of attributes.

Merriman et al. describe an advertising system in which a decision about which advertisement to select is based on an analysis of demographic or other information unrelated to the advertisement (or the characteristics of the advertisement) itself. In other words, there is no disclosure or suggestion in Merriman et al. to base the ad selection on a given characteristic (such as color, animation, message wording, or the like) of the advertisement variants, let alone on multiple such characteristics (a “multiattribute” approach) of a given advertisement. The system does not appear to track or use ad attributes for any purpose. The “multiattribute” nomenclature of the present invention (as described in the lexicon on page 21-22) is neither disclosed nor implicit within the four corners of the cited reference. Thus, the original anticipation rejection was misplaced and should be withdrawn.

Although the claim as originally filed was not anticipated by Merriman et al., new counsel of record has determined that the original wording lacked clarity. Accordingly, claim 1 is herein amended to describe two aspects of the invention with more precision. As amended, claim 1 now requires that the “historical information” be used to facilitate the determination of the importance of the attributes and the attribute values to the performance of the message

alternatives, and further that this determination be used to inform the subsequent step of “optimizing campaign performance through allocation of message alternatives during the multi-stage campaign.” Thus, amended claim 1 is now sufficiently clear that the historical performance data informs the determination about which attributes and attribute values (of the message alternatives) provide better performance, and that the allocation of message alternatives (e.g., for a next stage) is then based on this determination. This use of multiattribute “analysis and optimization” is neither disclosed nor remotely suggested by the art of record.

Claims 2-6, 8, 11-12, 15, 19-26, and 59-60 were rejected under 35 USC 103(a) as being unpatentable over Merriman et al., in view of Tamayo et al., U.S. Patent No. 6,836,773. Tamayo et al. are alleged to disclose pre-processing of web data to remove redundant or irrelevant information. Even if one of ordinary skill in the art would have been motivated to combine the references, which Applicants do not concede, the combination of these references is not the invention of any of claims 2-6, 8, 11-12, 15, 19-26 and 59-60 because of the underlying deficiencies in the Merriman et al. reference. Of course, the Office bears the burden of establishing prima facie obviousness in the first instance, and any proposed combination of these references does not disclose or suggest basing an ad selection in a given stage of a multi-stage advertising campaign on a given characteristic (such as color, animation, message wording, or the like) of the advertisement variants, let alone on multiple such characteristics (a “multiattribute” approach) of a given advertisement, as positively recited.

Claims 27-34 and 41-44 were rejected under 35 USC 103(a) as being unpatentable over Merriman et al., further in view of Tamayo et al., further in view of Dunning et al., U.S. Published Patent No. 2003/0229537. Dunning et al. is said to teach an expected value algorithm computation. This rejection is traversed for the reasons set forth above. In particular, even if one of ordinary skill in the art would have been motivated to combine the references, which Applicants do not concede, the combination of these references is not the invention of any of claims 27-34 and 41-44 because of the underlying deficiencies in the Merriman et al. reference previously discussed. In particular, the references do not disclose or suggest the multiattribute features of the present invention.

Claims 35-40 were rejected under were rejected under 35 USC 103(a) as being unpatentable over Merriman et al., further in view of Tamayo et al., further in view of Marsh et al., U.S. Patent No. 5,848,397. Marsh et al. is said to describe dividing advertisements into

prioritized advertised queues. Once again, and with respect, this rejection is traversed for the reasons set forth above. In particular, even if one of ordinary skill in the art would have been motivated to combine the references, which Applicants do not concede, the combination of these references is not the invention of any of claims 35-40 because of the underlying deficiencies in the Merriman et al. reference. The cited combination of references still do not disclose or suggest the multiattribute features of the present invention.

Claims 47 and 51-52 were rejected under 35 USC 103(a) as being unpatentable over Merriman et al., in view of Dunning et al. This rejection is also traversed for the reasons set forth above with respect to Merriman et al. The cited combination does not disclose or suggest the underlying multiattribute features.

Claims 53-57 were rejected under 35 USC 103(a) as being unpatentable over Merriman et al., in view of Dunning et al., further in view of Montague, U.S. Patent No. 6,954,731. Montague is said to teach the report generation functionality for producing custom reports. This rejection is traversed given the deficiencies in the Merriman et al. reference. The cited combination of references does not disclose or suggest the multiattribute features of any of claims 1, 58 or 64.

Accordingly, a Notice of Allowance is requested.

Respectfully submitted,

By



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